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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,632	05/03/1999	CHERYL B. LEBEAU	D-7102	8616

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EXAMINER

EVANISKO, LESLIE J

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/303,632

Applicant(s)

LEBEAU ET AL.

Examiner

Leslie J. Evanisko

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-26, 28-30, 32-37, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 27, 31 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The proposed drawing corrections were received on September 25, 2000 (paper #3). These drawings corrections are approved by the Examiner. Additionally note that the draftsperson objected to the drawings in the PTO-948 attached to paper #2. New formal drawings incorporating the approved changes and correcting the informalities set forth by the draftsperson should be submitted by applicant.

Response to Amendment

2. Note that under the new rule for making amendments under 37 CFR 1.121, note that the amendments to the claims must include a complete listing of all the claims, including claims that have been previously canceled. Thus, in the next filed response in this application, canceled claims 1-20 should also be listed in the listing of the claims.

Claim Objections

3. Claims 24 and 35 are objected to because of the following informalities:

With respect to claims 24 and 35, note that these claims are improper in that they each recite a structural connection to the keyboard and the claims are drawn to the cover per se and not the combination of a keyboard and cover.

Therefore, this language makes the scope of the claims somewhat unclear as to whether applicant is intending to claim the combination of the cover and the keyboard or just the cover per se. Since it appears from the claim language that applicant is intending to claim just the cover alone, it is suggested that the phrase "contact and protects" be deleted and replaced with --configured to contact and protect-- or similar language.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 32, 35-37, and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaible et al. (US 5,397,182). Gaible et al. teach an individual transparent bag or "cover" comprising a pair of identical flat and "entirely" transparent planar sheets of pliable plastic film of uniform thickness "throughout" being fastened along at least a bottom edge so as to be capable of enveloping entire upper and bottom surfaces of a keyboard. See Figure 2 and column 4, lines 34-38 of Gaible et al.

Note that although Gaible et al. do not necessarily teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and has no patentable significance to the claims. Thus, Gaible et al. teach a "cover" including all of the structure limitations as recited.

With respect to claim 37, note that Gaible et al. teach a sheet formed as an envelope with an elongated opening along a top edge portion as broadly recited.

With respect to claim 42, note that Gaible et al. teaches the two flat sheets are fastened together along each side edge portion with an opening along the top edge portion as recited.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 32 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US 5,812,188). Yanagisawa teaches an individual disposable transparent cover **34, 34'** comprising a flat and entirely transparent planar sheet of pliable film of uniform thickness throughout and a predetermined size in length and width for covering a keyboard as recited. See Figures 9-10 and column 11, lines 21-67 in particular. Note that although Yanagisawa does not specifically state that the cover is a plastic film as recited, note that Adair teaches the use of flexible transparent materials such as polyurethane, polyolefins, and laminated plastic films for a covering for a keyboard in a sterile environment is well known in the art. See Figures 1 and 5 and column 5, lines 2-16 and column 6, lines 38-55. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use a plastic film as taught by Adair for the flexible transparent film of cover of Yanagisawa as it would require simply the obvious selection of a known material based upon its known properties.

With respect to claim 35, note Yanagisawa teaches the cover may comprise an enclosure for enclosing the entire keyboard body in column 11, lines 36-37.

With respect to claim 36, note that Adair teaches the use of a cover member which comprises an upper member adapted to overlies the upper surface of a keyboard and a lower member adapted to underlie a bottom surface of a keyboard to completely enclose both the upper and bottom

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surfaces of a keyboard. Again, note Figure 5 in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide an upper and lower member on the sheet as taught by Adair to provide the cover of Yanagisawa to completely enclose the keyboard as desired.

With respect to claim 37, note Adair teaches a sheet formed as an envelope with an elongated opening along a top edge portion as broadly recited. Again, it would have been obvious to one of ordinary skill in the art to use the particular sheet configuration as taught by Adair for the cover of Yanagisawa to provide an enclosure for use in a sterile environment with an opening for allowing insertion of the keyboard inside the enclosure.

8. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair as applied to claims 32 and 35-37 above, and further in view of either of Okamura (US 5,089,690) or Young (GB 2 201 922 A). Yanagisawa in view of Adair teach a transparent cover as recited with the exception of the sheet including strips of adhesive along either or both of a top edge and bottom edge of the sheet. Note that Yanagisawa does teach the cover member includes attachment means for removably attaching the cover to the underlying keyboard in column 11, lines 24-29 and 34-36. Although the attachment means of Yanagisawa is not adhesive strips, note that the use of adhesive strips to attach a keyboard cover to a keyboard is well known in the art as exemplified by the teachings of both Okamura and Young.

See Figure 2 and column 3, lines 1-16 of Okamura and Figures 1B-1C and claims 1-2 of Young in particular. In view of these teachings, it would have been obvious to one of ordinary skill in the art to use adhesive strips as taught by each of Young and Okamura in the transparent cover of Yanagisawa, as it would require simply the obvious substitution of one known fastening means for another to provide secure attachment of the removable cover to the underlying keyboard.

9. Claims 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US 5,812,188) and IBM Technical Disclosure Bulletin, June 1994, Vol. 37, Issue 6B, pages 125-126. (referred to hereafter as the IBM reference). Yanagisawa teaches an individual disposable transparent cover **34, 34'** comprising a flat and entirely transparent planar sheet of pliable film of uniform thickness throughout and a predetermined size in length and width for covering a keyboard as recited. See Figures 9-10 and column 11, lines 21-67 in particular. Note that although Yanagisawa does not specifically state that the cover is a plastic film as recited, note that Adair teaches the use of flexible transparent materials such as polyurethane, polyolefins, and laminated plastic films for a covering for a keyboard in a sterile environment is well known in the art. See Figures 1 and 5 and column 5, lines 2-16 and column 6, lines 38-55. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use a plastic

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film as taught by Adair for the flexible transparent film of cover of Yanagisawa as it would require simply the obvious selection of a known material based upon its known properties.

Furthermore, note that although Yanagisawa teaches the covers are disposable and replaceable in column 11, lines 61-67, Yanagisawa is silent with respect to whether a plurality of these covers are provided in a package. However, the provision of a plurality of disposable items in a package is well known in the art as exemplified by commercially available packages of such disposable items as sandwich bags, trash bags, etc. Furthermore, the IBM reference teaches packs of individual disposable covers for covering handheld computer devices in the fourth paragraph on page 126. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pack having a plurality of the replaceable film cover of Yanagisawa as modified by Adair to facilitate discarding and replacing the covers as they become soiled or damaged.

With respect to claims 24-25, note the above comments with respect to claims 35-36.

With respect to claim 26, note the above comments with respect to claim 37.

10. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair and the IBM reference as

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applied to claims 21 and 24-26 above, and further in view of either of Okamura (US 5,089,690) or Young (GB 2 201 922). Yanagisawa in view of Adair and the IBM reference teach a package of individual disposable transparent covers as recited with the exception of the transparent cover including strips of adhesive along either or both of a top edge and bottom edge of the sheet. Note that Yanagisawa does teach the cover member includes attachment means for removably attaching the cover to the underlying keyboard in column 11, lines 24-29 and 34-36. Although the attachment means of Yanagisawa is not adhesive strips, note that the use of adhesive strips to attach a keyboard cover to a keyboard is well known in the art as exemplified by the teachings of both Okamura and Young. See Figure 2 and column 3, lines 1-16 of Okamura and Figures 1B-1C and claims 1-2 of Young in particular. In view of these teachings, it would have been obvious to one of ordinary skill in the art to use adhesive strips as taught by each of Young and Okamura in the transparent cover of Yanagisawa as modified by Adair and the IBM reference, as it would require simply the obvious substitution of one known fastening means for another to provide secure attachment of the removable cover to the underlying keyboard.

11. Claims 21, 24-26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaible et al. (US 5,397,182) in view of the IBM reference. Gaible et al. teach an individual transparent bag or "cover"

comprising a pair of identical flat and entirely transparent planar sheets of uniform thickness pliable plastic film being fastened along at least a bottom edge so as to envelope entire upper and bottom surfaces of a keyboard within the enclosure formed by the upper and lower sheet members. See Figure 2 and column 4, lines 34-38 of Gaible et al.

Note that although Gaible et al. do not necessarily teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and has no patentable significance to the claims. Thus, Gaible et al. teach a “cover” including all of the structure as recited.

Furthermore, although Gaible et al. is silent with respect to whether it includes a package containing a plurality of such bags, the provision of a plurality of disposable items in a package is well known in the art as exemplified by commercially available packages of such disposable items as sandwich bags, trash bags, etc. Furthermore, the IBM reference teaches packs of individual disposable covers for covering handheld computer devices in the fourth paragraph on page 126. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pack having a plurality of the bags of Gaible et al. to facilitate discarding and replacing the covers as they become soiled or damaged.

With respect to claims 29-30, note that Gaible et al. teaches the two flat sheets are fastened together along each side edge portion with an opening along the top edge portion as recited.

With respect to claim 30, to the extent applicant has defined which edge portions are which, note that depending upon the orientation of the cover and the viewing direction in which a user views the cover, the left and right edges of the bag illustrated in Figure 2 can be considered as the upper and lower edges as recited. Regardless, it would have been obvious to one of ordinary skill in the art to provide any three sides of the bag to be sealed to provide an enclosure for covering a keyboard.

Allowable Subject Matter

12. Claims 27, 31, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest a keyboard cover (or package of covers) including all of the structure as recited, in combination with and particularly including, the at least one flat and transparent sheet of pliable plastic film of uniform thickness and a predetermined size in length and width is formed as an envelope with an

elongated opening adjacent one corner and extending along one side edge portion and generally to a midpoint along a top edge portion.

Response to Arguments

13. Applicant's arguments with respect to claims 21-26, 28-30, 32-37, and 41-42 have been considered but they are not persuasive of any error in the above rejections.

In particular, applicant argues that Gaible et al. does not teach an entirely transparent planar sheet which has a uniform thickness throughout because the cover member of Gaible et al. includes projecting hook-like fasteners and an opaque web portion. However, the Examiner disagrees with this argument. In particular, it is the Examiner's position that the cover of Gaible et al. includes two identical flat transparent sheets of pliable plastic film 32a, 32b as recited. As taught by Gaible et al. in column 4, lines 34-52, the two webs 228, 230 (which includes the opaque portion and locking members 224, 226 applicant refers to) are separate members that are attached to the ends of the two flat and transparent sheets of plastic film. This is similar to applicant's own disclosed covers, which include various types of fastening members attached to the end portion of at least one of the identical sheets of uniform thickness throughout (see page 5, lines 7-9 and page 6, lines 8-12 of the specification.).

Additionally, applicant argues that Yanagisawa fails to teach a keyboard cover including a flat entirely planar sheet of uniform thickness throughout since the cover includes elastic band fastening members on the ends of the sheet. Again, the Examiner disagrees with this argument. Although Yanagisawa does teach the keyboard cover is provided with rubber band elements for fastening the cover to the keyboard in column 11, lines 21-35, it is the Examiner's position that these rubber band elements are not necessarily integrally formed in the thin cover, but merely an attachment to the thin cover of uniform thickness throughout.

Furthermore, applicant argues that Yanagisawa and Adair are not properly combinable since Yanagisawa is drawn to a sheet held in place by rubber bands while Adair is drawn to a bag for enveloping a keyboard. Again, the Examiner disagrees with this argument. Note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Yanagisawa and Adair are concerned with providing a protective cover for a keyboard and are considered to be analogous and their teachings to be properly combinable.

Applicant also argues that the teachings of Okamura and Young are not properly combinable with the teachings of Yanagisawa in view of Adair since

each of Okamura and Young are drawn to rigid keyboard covers and Yanagisawa and Adair are drawn to pliable film covers. The Examiner disagrees with this argument. Note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of Yanagisawa, Adair, Okamura, and Young are concerned with providing a protective cover for a keyboard or keypad and are considered to be analogous and their teachings to be properly combinable.

In view of the above reasons, the Examiner is not persuaded of any error in the applied rejections.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH


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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(703) 308-0786**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
December 29, 2003